

REMARKS

Claims 1, 2, 4, 5, 9, 10, 14, 15, 19, 20, 24, 25, 28 and 29 remain pending in the present application.

Claims 15, 25 and 28 over Borland in view of Jones

Claims 15, 25 and 28 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,556,965 to Borland et al. (“Borland”) in view of U.S. Patent No. 6,697,944 to Jones et al. (“Jones”). The Applicants respectfully traverse the rejections.

Claims 15, 25 and 28 recite downloading a digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source accessible by the remote handset via an Internet.

The Examiner acknowledged that Borland fails to disclose “downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source.” (See Office Action, page 3). However, the full claimed feature is “downloading a digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source accessible by the remote handset via an Internet”.

Examiner relies on Jones to allegedly make up for the deficiencies in Borland to arrive at the claimed invention. In particular, the Examiner alleges Jones “teaches downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source.” at col. 10, lines 9-14 (See Office Action, page 3). The Examiner later in the Office Action clarifies that the Examiner really means to rely on Jones at Fig. 3 to disclose downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source” (See Office Action, page 10).

Jones at col. 11, lines 18-44 and in Fig. 3 appears to disclose a portable device that is used to directly download a digital content file through the Internet. However, Jones fails to disclose or suggest any application to a remote handset of a cordless telephone, the full claim limitation, much less disclose downloading a digital bit stream music comprised in an MPEG format to

a remote handset directly from a remote bit stream audio source accessible by the remote handset via an Internet, as recited by claims 15, 25 and 28.

The Examiner alleges that the motivation to modify Borland with the disclosure of Jones is “to ensure proper protection and prevent unauthorized duplication thereof (see Jones, column 1, lines 8-14)” (See Office Action, page 3). The Applicants are unsure of HOW modifying Borland to “downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source” would “ensure proper protection and prevent unauthorized duplication thereof”. The Examiner has failed to show HOW the alleged modification would have such a benefit in Borland. In fact, nothing about the alleged modification of Borland would result in the benefit described by the Examiner. It is the ENTIRE disclosure of Jones that results in such a benefit NOT simply “downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source”. Once such content would be downloaded into the allegedly modified Borland, such content could STILL be easily duplicated, providing no proper protection. Thus, the particular feature that the Examiner points to in Jones has NOTHING to do with ensuring “proper protection and prevent unauthorized duplication thereof”.

Moreover, the Examiner is modifying Borland with the disclosure of Jones. The Examiner cites why Jones allegedly uses a particular feature. However, it would be the obviousness of MODIFYING Borland that is at issue, NOT why Jones relies on such a features. The Examiner has STILL failed to provide motivation WHY one of ordinary skill in the art would be motivated to modify Borland in the manner alleged by the Examiner. “Teachings of references can be combined only if there is some suggestion or incentive to do so.” In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). Nothing within Borland and/or within Jones suggests the alleged modification of Borland.

Moreover, the Examiner appears correct that Jones discloses “downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source”. However, Jones fails to disclose or suggest

application of such features to a cordless telephone, much less to a remote handset of a cordless telephone, as recited by claims 15, 25 and 28.

Moreover, the Examiner argues in the Response to Arguments section of the Office Action that Borland's invention "can perform as an MPEG audio player" (See Office Action, page 10). However, as Applicants previously pointed out, Borland RELIES on MPEG audio compression for the basic operation of telephone conversations, thus Borland's invention MUST perform as an MPEG audio player for TELEPHONE functionality. Borland fails to disclose or suggest connection of a telephone to anything other than a TELEPHONE network. Thus, NOTHING within Borland nor Jones suggests modification of a telephone device to connect to the Internet, much less for downloading a digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source accessible by the remote handset via an Internet, as recited by claims 15, 25 and 28.

Thus, Borland modified by Jones, even if it were an obvious modification of Borland which it is not as discussed above, fails to disclose or suggest downloading a digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source accessible by the remote handset via an Internet, as recited by claims 15, 25 and 28.

For these and other reasons, claims 15, 25 and 28 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 1, 2, 4, 5 and 29 over Borland in view of Rydbeck

Claims 1, 2, 4, 5 and 29 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Borland in view of International Publication Number WO 99143136 to Rydbeck et al. ("Rydbeck"). The Applicants respectfully traverse the rejections.

Claims 1, 2, 4, 5 and 29 recite a remote handset of a cordless telephone that can switch between performing as a telephony device and performing as an MPEG audio player.

The Examiner AGAIN argues in the Response to Arguments section of the Office Action that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. Applicants clearly are arguing herein, and in previous Responses the modification of Borland with Rydbeck, i.e., the combination of references, fails to disclose or suggest the claimed features.

Moreover, the Examiner's motivation to modify Borland with the disclosure of Rydbeck is "to prevent telephone conversations from interfering with audio sounds" (See Office Action, page 6). However, the Examiner has failed to show that Borland has a problem with telephone conversations interfering with audio sounds that needs some modification of Borland to fix the problem. "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original).

Moreover, nothing within Borland and/or Rydbeck suggest modifying Borland in the manner alleged by the Examiner. Borland's invention is to use audio compression, i.e., MPEG audio compression, for telephone functionality. Nothing within Borland and/or Rydbeck suggests modifying Borland in the manner alleged by the Examiner, i.e., nothing within Borland and/or Rydbeck suggests modifying Borland switch between ANY two functions, much less to modifying Borland to switch between performing as a telephony device and performing as an MPEG audio player, as recited by claims 1, 2, 4, 5 and 29.

Moreover, the Examiner has FAILED to REFUTE the fact, as Applicants previous pointed out in the last Response, that modification of Borland to switched out of an MPEG mode would DISABLE Borland's invention since the Borland's MPEG mode IS the telephone mode. Borland's MPEG audio player is the SAME as the telephone mode. Thus, modification of Borland that RELIES on an MPEG mode for its most basic operation to switch out of an MPEG mode would render Borland's invention useless. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP §2141.02, page 2100-127 (Rev. 2, May

2004) (citing W.L. Gore & Assoc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).

Moreover, the Examiner has FAILED to REFUTE the fact, as Applicants previous pointed out in the last Response, that modifying Borland to switch from an MPEG audio mode would leave a telephone without function since the telephone relies on MPEG audio for its basic functions. The Examiner's modification of Borlan would destroy the invention of Borland and would therefore be improper. See Ex parte Hartman, 186 U.S.P.Q. 336, 337 (P.T.O.B.O.A. 1974) (reversing rejection when modification would destroy basis for invention in one or two references). Therefore, the rejection should be withdrawn.

Moreover, the Examiner has FAILED to REFUTE the fact, as Applicants previous pointed out in the last Response, Rydbeck discloses a cellular telephone that includes an internally integrated digital entertainment module (Abstract). Audio is played back through a headset while a user engages in leisure activities and automatically mutes or stops playback of the audio until a call is terminated (See Rydbeck, page 7, lines 4-8). A cellular telephone is NOT a remote handset of a cordless telephone. Rydbeck fails to disclose or suggest application of any of the features disclosed for a cordless telephone, much less a remote handset of a cordless telephone. As discussed above, "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original).

Thus, modifying Borland with the disclosure of Rydbeck would STILL fail to disclose or suggest a remote handset of a cordless telephone that can switch between performing as a telephony device and performing as an MPEG audio player, as recited by claims 1, 2, 4, 5 and 29.

For these and other reasons, claims 1, 2, 4, 5 and 29 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 14 and 24 over Borland in view of Jones and Ng

Claims 14 and 24 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Borland in view of Jones, and further in view of U.S. Patent No. 6,430,530 to Ng (“Ng”). The Applicants respectfully traverse the rejections.

Claims 14 and 24 recite downloading digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source.

The Examiner acknowledges that Borland fails to “disclose downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source.” (See Office Action, page 7). The Examiner relies on Jones and Ng to allegedly make up for the deficiencies in Borland to arrive at the claimed features. The Applicants respectfully disagree.

The Examiner relies on Jones to disclose “downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source” at col. 10, lines 9-14 (See Office Action, page 7). However, as discussed above, Jones discloses an MP3 player that directly downloads music files from a remote source. However, Jones fails to even mention download of digital bit stream music to a telephony device, much less to a remote handset of a cordless telephone, i.e., downloading digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source, as recited by claims 14 and 24.

As discussed above, the Examiner alleges that the motivation to modify Borland with the disclosure of Jones is “to ensure proper protection and prevent unauthorized duplication thereof (see Jones, column 1, lines 8-14)” (See Office Action, page 6). The Applicants are unsure of HOW modifying Borland to “downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source” would “ensure proper protection and prevent unauthorized duplication thereof”. The Examiner has failed to show HOW the alleged modification would have such a benefit in Borland. In fact, nothing about the alleged modification of Borland would result in the benefit described by the Examiner. It is the ENTIRE disclosure of Jones that results in such a benefit

NOT simply “downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source”. Once such content would be downloaded into the allegedly modified Borland, such content could STILL be easily duplicated, providing no proper protection. Thus, the particular feature that the Examiner points to in Jones has NOTHING to do with ensuring “proper protection and prevent unauthorized duplication thereof”.

Ng is relied on to disclose “an MPEG format is stored in memory” (See Office Action, page 7). However, NG fails to disclose or suggest application to a cordless telephone. Thus, modifying Borland with the disclosures of Jones and Ng would STILL fail to disclose or suggest downloading digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source, as recited by claims 14 and 24.

Moreover, Borland is the ONLY reference of the three references relied on to reject claims 14 and 24 that has ANY relevance to a cordless telephone. None of the relied on references disclose or suggest MODIFYING a cordless telephone in ANY way, much less to perform downloading digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source. As discussed above, “Teachings of references can be combined only if there is some suggestion or incentive to do so.” In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original).

Thus, even it were obvious to modify Borland with the disclosure of Jones and Ng, which it is not as discussed above, the theoretically modified Borland would STILL fail to disclose or suggest downloading digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source, as recited by claims 14 and 24.

For these and other reasons, claims 14 and 24 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 9, 10, 19 and 20 over Borland in view of Tuoriniemi

Claims 9, 10, 19 and 20 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Borland in view of U.S. Patent No. 5,978,689 to Tuoriniemi et al. (“Tuoriniemi”). The Applicants respectfully traverse the rejections.

Claims 9, 10, 19 and 20 recite muting a playing of a pre-loaded MP3 music when a remote handset of a cordless telephone is active in a current telephone call.

The Examiner AGAIN argues in the Response to Arguments section of the Office Action that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. However, “Teachings of references can be combined only if there is some suggestion or incentive to do so.” In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). The Applicants previously argued and the Examiner has FAILED to REFUTE that modification of Borland in the manner suggested by the Examiner would leave Borland’s invention useless. Modification of Borland to mute playing of a pre-loaded MP3 music when a remote handset of a cordless telephone is active in a current telephone call would disable Borland’s invention since the MP3 mode IS the telephone mode. Thus, modification of Borland as the Examiner suggests that relies on an MPEG mode for its most basic operation would render Borland’s invention useless. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP §2141.02, page 2100-127 (Rev. 2, May 2004) (citing W.L. Gore & Assoc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).

The Examiner relies on Tuoriniemi to allegedly make up for the deficiencies in Borland to arrive at the claimed features. The Applicants respectfully disagree.

Tuoriniemi discloses a personal communication and audio set that is able to play a stored digital audio program (See Fig. 1; col. 9, lines 17-20). Tuoriniemi discloses a cordless telephone within the background of the invention,

however, Tuoriniemi's invention is directed to a personal communication and audio set that does not have the shortcomings associated with a cordless telephone. Thus, the Examiner has AGAIN FAILED to REFUTE Tuoriniemi TEACHES AWAY from applying any teachings to a cordless telephone. MPEP §2141.02, page 2100-127 (Rev. 2, May 2004) (citing W.L. Gore & Assoc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). Tuoriniemi's playing a stored digital audio program from a personal communication and audio set is NOT playing MP3 music from a remote handset of a cordless telephone, much less muting the playing of a pre-loaded MP3 music when the remote handset is active in a current telephone call, as recited by claims 9, 10, 19 and 20.

Moreover, Borland discloses the use of MPEG compression for a telephone conversation. The Examiner has FAILED to REFUTE the fact that modifying Borland to mute an MPEG formatted signal, as disclosed by Tuoriniemi, would result in muting a telephone conversation, which is nonsensical since it is the conversation that the user of a remote handset would want to hear. See Ex parte Hartman, 186 U.S.P.Q. 336, 337 (P.T.O.B.O.A. 1974) (reversing rejection when modification would destroy basis for invention in one or two references). Therefore, the rejection should be withdrawn.

Thus, even if it were obvious to modify Borland with the disclosure of Tuoriniemi, which it is not as discussed above, the theoretically modified Borland would STILL fail to disclose or suggest playing MP3 music from a remote handset of a cordless telephone and muting the playing of a pre-loaded MP3 music when the remote handset is active in a current telephone call, as recited by claims 9, 10, 19 and 20.

For these and other reasons, claims 9, 10, 19 and 20 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,



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